

### **REMARKS/ARGUMENTS**

Claims 1, 2, 6 and 8-10 are pending in this application. Claim 1 has been amended to more clearly recite the invention. These amendments are deemed to be entirely supported by the application as originally filed and thus they do not raise any issue of new matter. Entry of this Amendment is respectfully requested as it is believed to place the entire application in condition for an allowance. Upon such entry, claims 1, 2, 6 and 8-10, as amended, will be pending in the application.

### **Request For Address Change**

The Power of Attorney in the present application has been given by the applicant to the firm of Ostrolenk, Faber, Gerb & Soffen LLP located at 1180 Avenue of the Americas, New York, NY 10036-8403, Telephone: (212) 382-0700, Facsimile: (212) 382-0888 - Customer No. 2352. Notwithstanding this fact, however, the Office is respectfully informed that it has made a practice of sending correspondence (including Office Actions) concerning this application to an incorrect party, namely Phillips Intellectual Property & Standards 595 Miner Road, Cleveland, Ohio 44143. The Office is, therefore, requested to correct its records with regard to this matter and to forward all future correspondence concerning this application to the attention of Robert C. Faber, Esq. (Reg. No. 24,322) of the Ostrolenk, Faber, Gerb & Soffen LLP firm at the address noted above.

### **Claim Rejections Under 35 U.S.C. §112**

Claims 1, 2, 6 and 8-10 are rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the statute's 'written description' requirement. This rejection is respectfully traversed.

We turn, first, to the limitation, "said mold defining an opening in a lower portion thereof", which was added by amendment in applicant's previous response filed March 20, 2007. The Office Action states that figure 1(d), which was identified in the March 20, 2007 response as supporting the limitation, "schematically shows an opening in the bottom of the mold, and not in the "lower portion" of the mold which "lower portion" is not limited by the

bottom of the mold and encompasses other areas of the mold.” In response, therefore, to the Examiner’s rejection, applicant has amended claim 1 such that it now recites that the mold defines an opening, “in the bottom thereof”. This amendment, therefore, is believed to overcome the Examiner’s ground for rejection.

Turning, next, to the limitation, “such that a total void volume of said microspheres is greater than a total interstitial void volume defined by spaces between the microspheres”, the Office Action notes that the figure relied on for support for this amendment is clearly marked as a “diagrammatic” view and is, thus, not drawn to scale. The Office Action then goes on to state that, “it is not seen from the figure that there are ANY voids between the microspheres at all, as the spaces between the microspheres are filled with liquid phase and not ‘voids’.” In response to the Examiner’s rejection, applicant has further amended claim 1 to change, “the total interstitial void volume defined by spaces between the microspheres” to “the total volume between the microspheres”. Thus, the concept of there being “voids” between the microspheres has been removed from the subject claim to take into account the fact, as noted by the examiner, that the volume between the subject spheres is filled with a liquid. Applicant thus submits that this amendment is believed to overcome the Examiner’s second ground for rejection.

The Examiner is, therefore, respectfully requested to reconsider and withdraw the rejections of claims 1, 2, 6 and 8-10 under 35 U.S.C. §112, first paragraph.

Further to the above, the identical claims (nos. 1, 2, 6 and 8-10) are also rejected under 35 U.S.C. §112, second paragraph on p. 3 of the Office Action. The rejection is based on the limitation, discussed above, which was previously added to claim 1 reciting, “such that a total void volume of said microspheres is greater than a total interstitial void volume defined by spaces between the microspheres”. This rejection is also respectfully traversed.

As noted above, claim 1 has been amended in this response to change, “the total interstitial void volume defined by spaces between the microspheres” to “the total volume between the microspheres”. Thus, the concept of there being “voids” between the microspheres has been removed from the subject claim to take into account the fact, as noted by the examiner, that the volume between the subject spheres is filled with a liquid. Applicant thus submits that this amendment is believed to overcome the Examiner’s rejection under 35 U.S.C. §112, second

paragraph. The Examiner is, thus, respectfully requested to reconsider and withdraw the subject rejection.

### **Claim Rejections Under 35 U.S.C. §103**

Claims 1, 2 and 6-10 are again rejected under 35 U.S.C. 103(a) as being allegedly obvious over AU Patent Application No. 200151857 to De Toffol (“AU De Toffol”) [and] under 35 U.S.C. 103(a) over its U.S. corresponding patent No. 6,476,087 (“US De Toffol”). According to the Office Action, the rejection stands as per reasons of record. These rejections are respectfully traversed.

As discussed in applicant’s previous response, claim 1 has been amended to introduce the concept that the mold is provided in its ‘lower portion’ (which has since been amended to “bottom”) with an opening, i.e., for the purpose of causing excess liquid phase binder to flow from the mold during the manufacture of the syntactic foam which is the subject of applicant’s claims. The Examiner, however, argues in response that, in the absence of any specific dimension of the opening, the pores of the wicked mold disclosed by the reference define plural openings in the lower portion of the mold through which the excess of liquid phase flows away from the mold.

Applicant respectfully submits in response that the position, noted above, as taken by the Examiner is believed to be faulty in the following respect. If the Examiner is going to correlate the ‘opening’ noted in applicant’s claim with the ‘pores’ in the wicked mold described in the cited reference(s), it must be taken into account that the reference mold must intrinsically contain such pores over its entire surface, i.e., at the top, bottom and sides and not just at the bottom of the mold. Thus, rather than being provided with “an opening” in the bottom of the mold, if one adopts the Examiner’s interpretation, the mold described by the reference is provide with an almost uncountable ‘plurality’ of openings over its entire surface through which excess liquid phase may be passed. This is not just a difference in degree, therefore, from the claimed invention, it is a difference in kind. In sum, if one interprets the claimed opening as a ‘pore’ then the arrangement recited in, e.g., applicant’s claim 1 is distinguishable over the mold taught for use in the cited reference in that, in the mold of De Toffel, the excess binder may exit the mold

over its entire surface, and not just through an opening in the bottom of the mold as now claimed by applicant.

As also noted in applicant's previous response filed during the prosecution of this application, claim 1 was further amended to recite that the total void volume of the microspheres is greater than a total interstitial void volume defined by spaces between the microspheres. To begin with, as noted above in response to an objection raised by the Examiner that there are no 'voids' between the microspheres (i.e., the space between spheres is filled with a liquid), the applicant amended claim 1 such that it now recites that a total void volume of the microspheres is greater than, "a total volume between the microspheres". Applicant, therefore, relies upon this feature as a teaching away from the disclosure contained in the subject references to the effect that in the foams produced thereby, the interstitial void volume should be greater than the void volume of the microspheres. Applicant respectfully believes that the Examiner is engaging in a hindsight-based analysis, i.e., in reliance upon his own disclosure, when the Examiner argues (as he does on p. 5 of the Office Action) that the above-identified teaching found in the references should be interpreted as a, "clear suggestion to vary the volume of interstitial voids to vary the foam density depending on the desired end use of the foam." (Office Action, p. 5). Applicant suggests, instead, that the teaching provided in the reference should be relied upon for saying just what it says, i.e., that the interstitial void volume should be greater than the void volume of the microspheres. Applicant is, in point of fact, confused as to how the Examiner can interpret such a teaching as intending to mean that the interstitial void volume may be greater than or less than the void volume of the microspheres.

The Examiner goes on to point out in the paragraph bridging pp. 5-6 of the Office Action that in the instant specification there is no disclosure whatsoever regarding any 'voids' between the microspheres, or their volume, or their characteristics. In response, applicant will concede that the volume between the microspheres is filled with a liquid and, thus, claim 1 as noted above has now been amended to reflect that fact in that the claim (as amended) now recites that a total void volume of the microspheres is greater than, "a total volume between the microspheres".

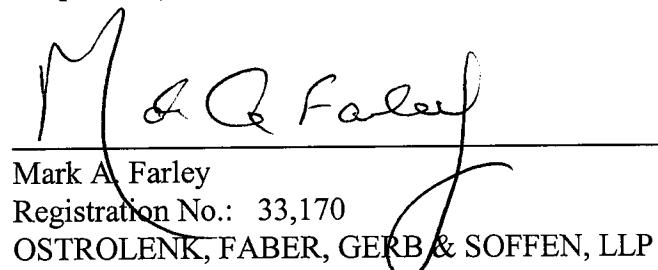
For the reasons above, therefore, applicant respectfully submits that the claims are amended are believed to distinguish the presently claimed method of manufacturing from both

AU De Toffol and US De Toffel. Thus, the Examiner is respectfully requested to reconsider and withdraw the rejections under 35 USC §103 based on those references so as to permit this application to pass through to allowance.

If the Examiner does not agree and believes that an interview might advance the prosecution of this application, he is respectfully invited to telephone applicant's representative at the number below in order that an interview concerning this application may be arranged.

Respectfully submitted,

THIS CORRESPONDENCE IS BEING  
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